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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,828	12/11/2001	Randy W. Jackson	240083.510	7196
500	7590	05/05/2004	EXAMINER	
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC			DAVIS, BRIAN J	
701 FIFTH AVE			ART UNIT	
SUITE 6300			PAPER NUMBER	
SEATTLE, WA 98104-7092			1621	

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,828

Applicant(s)

JACKSON ET AL.

Examiner

Brian J. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 55 is/are allowed.
- 6) ☒ Claim(s) 1-54 and 56-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The examiner notes for clarity of the record that the IDS received 3/11/02 (initialed and returned with the previous Office Action), although it correctly lists the instant application number and first-named inventor, has a different attorney docket number. Indeed, the cited references are clearly not germane to the instant invention. (The references are related to games, e.g. golf.)

112 Rejections Withdrawn

The rejection of claim 71 under 35 USC 112, second paragraph, outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment clarifies the variable substituent definitions as appropriate.

102 Rejections Withdrawn

The rejection of claims 1-82, in so far as they read on the species defined in the previous Office Action, under 35 USC 102(b), outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment narrows the independent claim by proviso such that the claims no longer read on the cited prior art.

The search was therefore expanded as called for under current Office Markush practice, a compound-by-compound search. This resulted in all remaining species being searched. A rejection follows:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-54 and 56-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Tetrahedron* (1970), 26(6), p. 1435-51 (CAPLUS abstract, prior art of

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record). (The examiner notes for clarity of the record that the CAPLUS abstract of the cited prior art included with this Office Action contains a more complete list of the compounds taught by *Tetrahedron* (1970), 26(6), p. 1435-51 than the abstract used in the previous Office Action.)

Applicant teaches a set of compounds of formula (I) (claim 1). The dependent claims further define the compound, its method of use and process of making.

Tetrahedron (1970), 26(6), p. 1435-51 (CAPLUS abstract) teaches a set of adjacent structural homologs of the instant set of compounds, for instance: RN=29206-51-7; 29196-80-3 and 29073-64-1. Adjacent homologs are considered to be obvious absent unexpected results. *In re Henze*, 85 USPQ 261, 263 (CCPA 1950). Members of a homologous series must possess unexpected properties not possessed by the homologous compounds disclosed in the prior art. *In re Hass*, 141 F.2d 127, 60 USPQ 548 (CCPA 1980).

The examiner respectfully suggests that expansion of applicant's proviso in claim 1 to read: "...when R⁶ is H, methyl or ethyl, and R⁴ and R⁵ together form =O or R⁴ is H and R⁵ is hydroxyl, and R¹ is -C(O)OR⁹, then R² is not -OH, -OCH₃ or -OCH₂CH₃ ..." would overcome the above rejection.

Allowable Subject Matter

The elected species and its obvious variant, defined in the previous Office Action, remain free of the prior art. Claim 55 is allowed as it is drawn to the elected species.

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(Claim 55 should have been stated as allowable in the previous Office Action. The examiner regrets the error.)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 **BRIAN DAVIS**
PRIMARY EXAMINER

Brian J. Davis
April 30, 2004